

REMARKS

Claims 1-3 and 7-15, and 28-39, are pending in this application. Claims 1-3 and 7-15 have been withdrawn from consideration. Claims 4-6 and 16-27 have been canceled. Claims 28, 29, and 32-39, have been amended.

Applicants thank the Examiner and his supervisor for indicating that claims 28-39 would be allowable if amended as suggested by the Examiner during the telephone interview of April 24, 2006 with the undersigned. Claims 28, 29, and 32-39, have been amended to reflect most of the Examiners suggestions discussed during the interview.

Claims 28 and 29 have been amended to replace the term "represented by" with the term "comprising" and to replace the term "an" with the term "the," as suggested. Claim 29 has also been amended to recite the phrase "under washing conditions" as suggested by the Examiner. Claims 32-35 have been amended to replace the language "A cell" with the language "An isolated cell" as suggested. Claims 36-39 have been amended to delete the phrase "or a cell comprising the glutamic acid receptor protein."

Amended claims 28, 29, and 32-39 find support throughout the specification, Examples, and claims, as originally filed. No new matter has been added.

In view of the remarks set forth herein, further and favorable consideration is respectfully requested.

I. Claims 28-39 remain rejected under 35 USC § 112, first paragraph.

The Examiner asserts that the hybridization condition of claim 29 is not clear from the specification because the specification discloses a wash condition. The Examiner further asserts that claims 36-39 do not include a method step for producing a transformant. In addition, the Examiner asserts that the claims have other enablement issues in that they recite "a cell" and "represented by." In view of the following, this rejection is respectfully traversed.

Claims 28 and 29 have been amended to replace the term "represented by" with the term "comprising" and to replace the term "an" with the term "the" at line 3 as suggested. Claim 29 has also been amended to recite the phrase "under washing conditions" as suggested by the Examiner. Claims 32-35 have been amended to replace the language "A cell" with the language "An isolated cell" as suggested. Claims 36-39 have been amended to delete the phrase "or a cell comprising the glutamic acid receptor protein."

With regard to the Examiners assertion that claims 36-39 are improper because they do not include a method step (method of transforming), Applicants note that claims 36-39 are directed to a method of producing glutamic acid receptor protein comprising cultivating a cell transformed with a DNA molecule encoding a specific, novel, glutamic acid protein in an expressible form, in a medium. Applicants assert that methods of transforming are well known to those of ordinary skill in the art and are not a critical feature of the method of claims 36-39 as is clearly discernable from the present specification. Rather, it is the specific glutamic acid protein of claims 36-39 that is novel and not the method of transforming.

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In further support of the above, the Examiners attention is directed to MPEP § 2164.08(c). This section of the MPEP requires the inclusion of a feature in a claim when the feature is taught as critical in a specification and is not recited in the claims. Further, this section recites that features which are merely preferred are not to be considered critical. MPEP § 2164.08(c) recites the following:

...therefore an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made **only** when the language of the specification makes it clear that the limitation is critical for the invention to function as intended. **Broad language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality.** (Emphasis added)

In the present case, the specification clearly teaches that a step of “transforming” is not critical to the invention. Page 8 of the present specification describes specific glutamic acid receptor proteins having certain properties, for example, comprising certain sequences. Page 9 of the specification describes a cell harboring a DNA that encodes a specific glutamic acid protein and a method for producing the glutamic acid receptor protein comprising cultivating the cell harboring the DNA, in a medium.

The method for producing glutamic acid receptor protein is described in the Detailed Description **only** on page 16, lines 11-20. Page 16, lines 11-15 recite:

...The techniques necessary for the manipulation of cells such as introduction of DNA therein are described in, for example, Sambrook, J., Fritsch, EG/, and Maniatis, T., “Molecular Cloning A Laboratory Manual, Second Edition”, Cold Spring Harbor Laboratory Press, (1989).

Page 16 at lines 16-20 of the specification, describes that a glutamic acid receptor protein can be produced by cultivating a cell that harbors the DNA encoding the mGluR4 variant obtained as described above in an expressible form in a medium to produce the protein. Clearly, the present specification describes that the production of glutamic acid receptor protein is not dependent on the method of transformation. In addition, the abstract appearing on page 36 of the specification broadly describes the glutamic acid receptor protein only and does not describe a method of transforming step.

Accordingly, it is submitted that a method step of transforming a cell is not a critical limitation because the specific method of transforming is not critical for the inventive method to function as intended. See MPEP § 2164.08(c) Further, the present specification broadly describes the claimed method of producing a glutamic acid receptor protein, and incorporates and relies on a teaching reference published in 1989 as teaching specific methods and techniques for introducing DNA into cells.

In view of the above, it is submitted that claims 28-39 fully comply with the written description and enablement requirements of 35 USC § 112, first paragraph. Thus, the Examiner is respectfully requested to withdraw this rejection.

CONCLUSION

In view of the foregoing, Applicants submit that the pending claims are in condition for allowance. Early notice to that effect is earnestly solicited. The Examiner is invited to contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,

NATH & ASSOCIATES PLLC



Gary M. Nath
Registration No. 26,965
Susanne M. Hopkins
Registration No. 33,247
Customer No. 20259

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NATH & ASSOCIATES PLLC
112 South West Street
Alexandria, VA 22314
Tel: (703) 548-NATH
Fax: (703) 683-8396